

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Patent Application of:
Naoyoshi Yamada

Application No.: 10/596,827

Confirmation No.: 1997

Filed: June 26, 2006

Art Unit: 1625

For: OCTAHYDRONAPHTHALENE DERIVATIVE Examiner: P. L. Morris
AND MEDICINE

RESPONSE TO RESTRICTION REQUIREMENT

MS Amendment
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Dear Sir:

In the Office Action dated October 26, 2007, the Examiner has required restriction of the claims to one of the following:

- Group I: the instances where R¹ and R² represent alkyl substituted by pyridyl;
- Group II: the instances where R¹ and R² represent alkyl substituted by phenyl;
- Group III: claims 16 and 17, drawn to multiple uses.

The Examiner has also required provisional election of a species to which the claims will be restricted should a generic claim not be held to be allowable.

Applicants hereby elect Group I, and elect the Species: N-(pyridin-3-ylmethyl)-(2E, 4E)-5-[(1S, 2S, 4aR, 6R, 7S, 8S, 8aS)-7-hydroxy-2,6,8-trimethyl-1,2,4a,5,6,7,8,8a-octahydronaphthalen-1-yl]-2-methylpenta-2,4-dienamide. Further, applicants elect as a disease “cancer”, in keeping with the anti-cancer agent described in the specification. This election is made with traverse. The instant claim 1 calls for an octahydronaphthalene core with one substituent R, which may be $-\text{CONR}^1\text{R}^2$, where R^1 and R^2 may be alkyl which may be substituted by a substituted phenyl group or a 2, 3 or 4 pyridyl group. The Markush group in the instant claim 1 presents a fairly narrow genus of compounds, all of which are readily envisioned. We therefore contend that a search of the compounds and their uses would not constitute an undue burden on the Examiner and, therefore, there exists unity of invention.